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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/462,925	06/02/2000	LIONEL JEAN	GEM-400	5660

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EXAMINER

ZIA, SYED

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 05/24/2004

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/462,925

Applicant(s)

JEAN ET AL.

Examiner

Syed Zia

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. ***Response to Amendment***

This office action is in response to amendment filed on March 10, 2004 (Paper No. 10). Original application contained Claims 1-24. Applicant amended Claims 2-4, 13-14, 17, 20, 2, and 23 to overcome claim objection of previous office action (Paper No. 8). The amendment filed have been entered and made of record. Presently pending claims are 1-24.

2. ***Response to Arguments***

Applicant's arguments filed on March 10, 2004 (Paper No. 11) have been fully considered but they are not persuasive because of the following reasons:

Regarding Claims 1 applicants argued that the cited prior arts (CPA) [Tamada et al. U.S. Patent No. 4,879,645] at least do not teach, "*preventing a defrauder from removing the security module from a terminal and discovering the secured information stored therein*" and CPA do *not disclose* "*freezing the terminal such that no one is able to use the terminal unit...*". This is not found persuasive. CPA clearly teaches method of managing a secure terminal in data processing system using a system of smart card. Prior to the running of each program by the secure terminal, it is judged whether or not the program is a specific one. If it is the specific program, the execution counter counts up and when the count value reached a predetermined limit, the running of that program is prevented, thus making the secure terminal unavailable (abstract).

As a result, CPA does implement and teaches a system and method of managing a secure terminal.

Applicants clearly have failed to explicitly identify specific claim limitations, which would define a patentable distinction over prior arts.

The examiner is not trying to teach the invention but is merely trying to interpret the claim language in its broadest and reasonable meaning. The examiner will not interpret to read narrowly the claim language to read exactly from the specification, but will interpret the claim language in the broadest reasonable interpretation in view of the specification. Therefore, the examiner asserts that CPA does teach or suggest the subject matter broadly recited in independent Claims 1, 12, and in subsequent dependent Claims 2-11, and 13-24. Accordingly, rejections for claims 1-24 are respectfully maintained.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2131

6. Claims 1-5, 7-15, and 17-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Tamada et al. U.S. Patent No. 4,879,645 ('Tamada' hereinafter). With respect to claim 1, Tamada disclose a method of managing a secure terminal used for transactions with smart cards (see abstract; Fig. 1), comprising:

placing a smart card in contact with the terminal (see Fig. 1; col. 1, lines 46-49);

executing a program by the terminal, this program including sensitive operations related to making the transactions secure (see col. 2, lines 32-40);

counting the number of times a request is made tot the terminal to execute sensitive operations (see col. 1, lines 36-43; col. 2, lines 54-62);

restricting the action of this terminal when this count reaches a predetermined value (see col. 1, lines 36-43; col. 4, lines 3-9).

7. Claim 2 rejected as above in rejecting claim 1, further comprising:

providing the terminal with a removable electronic security circuit (see Fig. 1; col. 2, lines 13-20), and

counting in this circuit, the number of requests for sensitive operations which are made to it or sensitive operations executed by it (see col. 2, lines 54-62).

8. Claim 3 rejected as above in rejecting claim 1, further comprising:

dividing the sensitive operations into a number of classes (see col. 3, lines 4-22) and;

establishing a count for each class (see col. 3, lines 23-37).

9. Claim 4 rejected as above in rejecting claim 1, further comprising:

as sensitive operation, performing a mutual identification procedure between the terminal and the card (see col. 2, lines 13-31).

10. Claim 5 rejected as above in rejecting claim 1, further comprising:

as a sensitive operation, performing an authentication (PIN) of a carrier of the smart card (see col. 2, lines 14-31).

11. Claim 7 rejected as above in rejecting claim 1 wherein the counter is re-initialized by a secure procedure including a verification of a secret code by the terminal or the security circuit (see col. 2, lines 32-44; col. 3, lines 29-37).

12. Claim 8 rejected as above in rejecting claim 7, wherein the secure procedure includes a verification of a secret code by the terminal or the security circuit (see col. 2, lines 32-44).

13. Claim 9 rejected as above in rejecting claim 7, wherein the re-initialization is performed remotely by a master system (see col. 2, lines 45-53; col. 3, lines 29-37).

14. Claim 10 rejected as above in rejecting claim 1, wherein the counter is incremented after a successful sensitive operation (see Fig. 4; col. 2, lines 54-62).

15. Claim 11 rejected as above in rejecting claim 1, wherein for restricting, only some of the operations of the planned transaction are prevented (see col. 2, lines 54-62; col. 4, lines 10-25).

16. Claim 12 rejected as above in rejecting claim 1, wherein the management means is capable of identifying and counting requests coming from outside and restricting its functions as soon as the count reaches a predetermined number (see col. 2, lines 54-62).

17. Claim 13 rejected as above in rejecting claim 2, further comprising:

dividing the sensitive operations into a number of classes (see col. 3, lines 4-22) and; establishing a count for each class (see col. 3, lines 23-37).

Art Unit: 2131

18. Claim 14 rejected as above in rejected claim 13, further comprising:

as sensitive operation, performing a mutual identification procedure between the terminal and the card (see Fig. 1; col. 1, lines 46-49; col. 2, lines 13-22).

19. Claim 15 rejected as above in rejecting claim 14, further comprising:

as a sensitive operation, performing an authentication (PIN) of a carrier of the smart card (see col. 2, lines 14-31).

20. Claim 17 rejected as above in rejecting claim 13, wherein a counter is re-initialized by a secure procedure including a verification of a secret code by the terminal or the security circuit (see col. 2, lines 27-44; col. 3, lines 29-37).

21. Claim 18 rejected as above in rejecting claim 17, wherein the secure procedure includes a verification of a secret code by the terminal or the security circuit (see Fig. 3; col. 2, lines 32-44).

22. Claim 19 rejected as above in rejecting claim 17, wherein the re-initialization is performed remotely by a master system (see col. 2, lines 45-53; col. 3, lines 29-37).

23. Claim 20 rejected as above in rejecting claim 13, wherein a counter is incremented after a successful sensitive operation (see col. 4, lines 19-25).

24. Claim 21 rejected as above in rejecting claim 13, wherein for restricting, only some of the operations of the planned transaction are prevented (see col. 2, lines 54-62; col. 4, lines 10-25).

25. Claim 22 rejected as above in rejecting claim 13, wherein the management means is capable of:

identifying and counting requests coming from outside and restricting its functions as soon as one of the counters reaches a predetermined number (see col. 4, lines 10-25).

Art Unit: 2131

26. Claim 23 rejected as above in rejecting claim 19, wherein a counter is incremented after a successful sensitive operation (see Fig. 4; col. 2, lines 54-62).

27. Claim 24 rejected as above in rejecting claim 19, wherein for restricting, only some of the operations of the planned transactions are prevented (see col. 2, lines 54-62; col. 4, lines 10-25).

Claim Rejections - 35 USC § 103

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. Claim 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamada et al. U.S. Patent No. 4,879,645 ('Tamada' hereinafter) in view of Asad et al. U.S. Patent No. 6,539,093 ('Asad' hereinafter).

30. With respect to claim 6, Tamada teach all the limitations as above as indicated in claim 1.

Tamada does not disclose a sensitive operation, performing a verification of a certificate coming from a smart card.

However, Asad discloses a sensitive operation, performing a verification of a certificate coming from a smart card (see col. 3, lines 43-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Asad within the system of Tamada to arrive at the invention as claimed because both references are directed to placing a smart card in contact with

Art Unit: 2131

a terminal, and because the implementation of performing a verification of a certificate of Asad in Tamada would further certify that the information coming from the smart card is authentic and that the card is authorized to access the terminal, further increasing the level of security and extending the capabilities of the combined system.

30. With respect to claim 6, Tamada teach all the limitations as above as indicated in claim 13.

Tamada does not disclose a sensitive operation, performing a verification of a certificate coming from a smart card.

However, Asad discloses a sensitive operation, performing a verification of a certificate coming from a smart card (see col. 3, lines 43-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Asad within the system of Tamada to arrive at the invention as claimed because both references are directed to placing a smart card in contact with a terminal, and because the implementation of performing a verification of a certificate of Asad in Tamada would further certify that the information coming from the smart card is authentic and that the card is authorized to access the terminal, further increasing the level of security and extending the capabilities of the combined system.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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Art Unit: 2131

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Zia whose telephone number is 703-305-3881. The examiner can normally be reached on Monday - Friday 9:00 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SZ

May 17, 2004


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
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